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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/658,689	09/10/2003	Thorsten Scherbarth	41653-191002	2171
26694	7590	11/01/2004	EXAMINER	
VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP			TAWFIK, SAMEH	
P.O. BOX 34385			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20043-9998			3721	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	Application No. 10/658,689	Applicant(s) SCHERBARTH ET AL.	
	Examiner Sameh H. Tawfik	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 17-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-16 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09102003</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
6) <input type="checkbox"/> Other: _____. |
|--|---|

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I (claims 1-16) in the reply filed on 08/23/2004 is acknowledged.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The disclosure is objected to because of the following informalities:

In (specification page # 12; line 7) “..cutting/pushing drum 15..”; and in (specification page #13; line 20) “..cutting/pushing drum 16..”; clarification is required for using two different element numbers 15 and 16 for pointing out to the cutting/pushing drum.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 5, and 10-16 are rejected under 35 U.S.C. 102(a) as being anticipated by Heitmann EP. (1,226,765).

Heitmann discloses a method for producing multi-segment filter elements in the tobacco-processing industry, wherein the multi-segment filter elements each include a first filter segment

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and at least one second filter segment, the method comprising arranging a sleeve element (Fig. 4; via 22-24) in the first filter segment (Fig. 4; via 20); inserting the second filter (the second 20) segment into the sleeve element in the first filter segment (Fig. 7; via two segments 20 passes by sleeves 22-24); and arranging a sleeve element pulling the sleeve element out (Fig. 9; sleeves 22-24 pulled out).

Regarding claim 2: compacting the material of the first filter segment (20) prior to arranging the sleeve element (Fig. 4; via by bushing element 20 prior to be inserted to sleeve 22).

Regarding claims 3 and 5: the compacting step includes compacting the material of the first filter segment with a mandrel element with low friction surface (via 17).

Regarding claim 10: arranging the second filter segment inside the sleeve element (Figs. 7 and 8; via both segment 20 passes by sleeve 23).

Regarding claim 11: securing the first filter segment in place before the material of the first filter segment is compacted (Fig. 7; via securing 1st element 20 inside 11 prior to inserting 2nd element 20 and pressing in it).

Regarding claim 12: pulling out the sleeve element (Figs. 8 and 9; via sleeve 23) from the first filter segment and then releasing the first filter segment (Fig. 7; via pulling out 23 and releasing the segment 20 down).

Regarding claims 13-16: transferring the respective filter elements to a conveying mechanism (via 17 and 12) following the step of pulling out the sleeve element, wherein the conveying mechanism is drum (Figs. 7-9; via 17) to produce filter element (Fig. 18).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heitmann EP. (1,226,765).

Heitmann does not disclose that admitting the mandrel element with ultrasound. However, the examiner takes an official notice that using an ultrasound to move a part is old, well known, and available in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Heitmann's mandrel 17 by using ultrasound to move it up and down, in order to control the movement of mandrel 17.

Regarding claim 6: Heitmann does not disclose that the mandrel coated with one of ceramic and electroplated chromium. However, the examiner takes an official notice that mandrel coated with one of ceramic and electroplated chromium is old, well known, and available in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Heitmann's mandrel by coating it with one of ceramic and electroplated chromium, in order to avoid any creation of heating therefore making the movement of the mandrel easier and smoother.

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Allowable Subject Matter

Claims 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

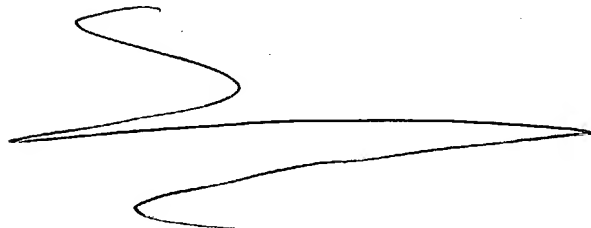
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is (703) 308-2809. The examiner can normally be reached on Tuesday - Friday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sameh H. Tawfik
Patent Examiner
Art Unit 3721



ST.